

## **REMARKS**

In response to the above-identified Office Action ("Action"), Applicants traverse the Examiner's rejection of the claims and seek reconsideration thereof. Claims 1, 5 and 8-35 are now pending in the present application. Claims 1, 8 and 10-28 remain withdrawn. Claims 5, 9 and 29-35 are rejected. In the instant response, claim 5 is amended, no claims are added and no claims are cancelled.

### **I. Examiner Interview**

Applicants respectfully acknowledge with appreciation the Examiner's granting of an interview on October 8, 2008 by telephone with Applicants' representative. During the interview, the rejection of claims 5, 9 and 29-35 under 35 U.S.C. §112, first paragraph was discussed. Applicants' representative proposed amending claim 1 to clarify that the additive is one of Si, B, Ge, Ga, Ca, Sr, and Ba and/or oxides thereof. The Examiner suggested that the claim should be amended to recite the additive is one of Si, B, Ge, Ga, Ca, Sr, and Ba and oxides thereof since this language follows the phrase "consisting of." Accordingly, Applicants have amended claim 5 as proposed by the Examiner. No other agreements were reached during the interview.

### **II. Claim Amendments**

Applicants respectfully submit herewith an amendment to claim 5. Claim 5 is amended to recite the element of "the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof." Support for the amendment to claim 5 may be found, for example, on page 8, lines 15-25 of the Application.

Applicants respectfully submit the amendment does not add new matter and is supported by the specification. Accordingly, Applicants respectfully request consideration and entry of the amendment to claim 5.

### **III. Claims Rejected Under 35 U.S.C. § 112**

In the outstanding Action, claims 5, 9 and 29-35 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. As previously

discussed, claim 5 is amended to replace the language found confusing by the Examiner with the element of “the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof.”

Applicants believe in view of the foregoing amendment, claim 5 and its dependent claims 9 and 29-35 are in compliance with 35 U.S.C. § 112. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 5, 9 and 29-35 under 35 U.S.C. § 112.

#### **IV. Claims Rejected Under 35 U.S.C. § 103**

A. In the outstanding Action, claims 5, 29, 30, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,869,208 issued to Miyasaka (“Miyasaka”) in view of U.S. Patent No. 6,379,842 issued to Mayer (“Mayer”). Applicants respectfully traverse the rejections as follows.

To establish a *prima facie* case of obviousness, the Examiner must set forth “some articulated reasoning with some rational underpinning to support the conclusion of obviousness.” See KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

In regard to independent claim 5, Applicants respectfully submit Miyasaka and Mayer fail to disclose or render predictable at least the elements of “forming a positive electrode by physically mixing a positive active material with an additive to prepare a positive active material composition, the positive active material being selected from the group consisting of lithiated transition metals, and the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof, coating the positive active material composition on a current collector after heat treating to place the positive active material in a uniform crystalline form; and drying the current collector coated with a positive active material slurry composition” as recited in claim 5.

The Examiner admits that Miyasaka and Mayer fail to disclose an oxide additive with an element of Si, B, Ga, Ge, Ca, Sr or Ba. See Action, page 10. The Examiner suggests that if adequate support is provided for the oxide element including any one of Si, B, Ga, Ge, Ca, Sr

and Ba, the claim rejections based on the cited prior art will be withdrawn. As previously discussed, claim 5 recites “the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof” and support for this element has been shown. Thus, for at least the reasons recognized by the Examiner and those discussed in the previous Response dated June 25, 2008, Miyasaka and Mayer fail to disclose or render predictable at least this element of claim 5. Since each of the elements of claim 5 are not found within the cited prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103 over Miyasaka and Mayer.

In regard to claims 29, 30, 33 and 34, these claims depend from claim 5 and incorporate the limitations thereof. Thus, for at least the reasons that claim 5 is not *prima facie* obvious over Miyasaka and Mayer, claims 29, 30, 33 and 34 are further not obvious over the prior art. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 29, 30, 33 and 34 under 35 U.S.C. §103 over Miyasaka and Mayer.

**B.** In the outstanding Action, claims 5, 29, 30, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,851,696 issued to Saidi et al. (“Saidi”) in view of Mayer. Applicants respectfully traverse the rejections as follows.

In regard to independent claim 5, Applicants respectfully submit Saidi and Mayer fail to disclose or render predictable at least the elements of “forming a positive electrode by physically mixing a positive active material with an additive to prepare a positive active material composition, the positive active material being selected from the group consisting of lithiated transition metals, and the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof, coating the positive active material composition on a current collector after heat treating to place the positive active material in a uniform crystalline form; and drying the current collector coated with a positive active material slurry composition” as recited in claim 5.

The Examiner admits that Saidi and Mayer fail to disclose an oxide additive with an element of Si, B, Ga, Ge, Ca, Sr or Ba. See Action, page 10. The Examiner suggests that if adequate support is provided for the oxide element including any one of Si, B, Ga, Ge, Ca, Sr and Ba, the claim rejections based on the cited prior art will be withdrawn. As previously discussed, claim 5 recites “the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides

thereof” and support for this element has been shown. Thus, for at least the reasons recognized by the Examiner and those discussed in the previous Response dated June 25, 2008, Saidi and Mayer fail to disclose or render predictable at least this element of claim 5. Since each of the elements of claim 5 are not found within the cited prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103 over Saidi and Mayer.

In regard to claims 29, 30, 33 and 34, these claims depend from claim 5 and incorporate the limitations thereof. Thus, for at least the reasons that claim 5 is not *prima facie* obvious over Saidi and Mayer, claims 29, 30, 33 and 34 are further not obvious over the prior art. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 29, 30, 33 and 34 under 35 U.S.C. §103 over Saidi and Mayer.

C. In the outstanding Action, claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Saidi in view of Mayer and further in view of U.S. Patent Publication No. 2001/0010807 issued to Matsubara (“Matsubara”). Applicants respectfully traverse the rejections as follows.

Claim 35 depends from claim 5 and incorporates the limitations thereof. For at least the reasons previously discussed, Saidi and Mayer fail to disclose at least the element of “the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof” as recited in claim 5. The Examiner has further not pointed to, and Applicants are unable to discern, a portion of Matsubara curing the deficiencies of Saidi and Mayer with respect to at least this element. Since each of the elements of claim 35 are not found within the prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 35 under 35 U.S.C. §103 over Saidi, Mayer and Matsubara.

D. In the outstanding Action, claims 5, 9 and 29-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,589,694 issued to Gosho et al. (“Gosho”) and further in view of Mayer. Applicants respectfully traverse the rejections as follows.

In regard to independent claim 5, Applicants respectfully submit that for at least the reasons previously discussed, Mayer fails to disclose or render predictable at least the elements

of “the additive at least one of Si, B, Ge, Ga, Ca, Sr and Ba and oxides thereof” as recited in claim 5. The Examiner further admits that Gosho fails to disclose an oxide including any one of Si, B, Ge, Ga, Ca, Sr and Ba. Thus, for at least the foregoing reasons, the combination of Gosho and Mayer fails to disclose or render predictable each and every element of claim 5. Since each of the elements of claim 5 are not found within the cited prior art, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103 over Gosho and Mayer.

In regard to claims 9 and 29-32, these claims depend from claim 5 and incorporate the limitations thereof. Thus, for at least the reasons that claim 5 is not *prima facie* obvious over Gosho and Mayer, claims 9 and 29-32 are further not obvious over the prior art. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 9 and 29-32 under 35 U.S.C. §103 over Gosho and Mayer.

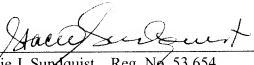
### CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Respectfully submitted,

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#### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on October 14, 2008.

  
Suzanne Johnston